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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,260	08/15/2001	Benjamin Mandler	MANDLER=1	9743
1444	7590	09/11/2006	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			RIMELL, SAMUEL G.	
			ART UNIT	PAPER NUMBER
			2164	

DATE MAILED: 09/11/2006

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**Technology Center 2100**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/929,260  
Filing Date: August 15, 2001  
Appellant(s): MANDLER ET AL.

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Roger L. Browdy  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 14, 2006, and the supplement to the Appeal Brief filed June 26, 2006, appealing the final rejection of August 8, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

Applicant submitted one amendment to the claims after the final rejection. The amendment was submitted March 13, 2006. The amendment addresses matters of minor grammatical correction and antecedence and is approved for entry. The status of the claims are otherwise correct as described.

**(4) Status of Amendments After Final**

The amendment after final rejection of March 13, 2006 has been approved for entry.

**(5) Summary of Claimed Subject Matter**

The Summary of Claimed Subject Matter collectively defined in both appellant's brief of March 14, 2006 and further including appellant's supplement of June 26, 2006 are correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection on appeal is a summary of the prosecution history of the application. This is only one issue on appeal: Whether claims 67-68, 76-80 and 88-89 are properly rejected under 35 USC 102(e) as being anticipated by Mandler et al. (U.S. Pre-Grant Publication 2001/0049675).

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Mandler et al. (U.S. Pre-Grant Publication 2001/0049675)

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 67-68, 76-80 and 88-90 are rejected under 35 U.S.C. 102(e) as being anticipated by Mandler et al. (US Pre-Grant Publication US 2001/0049675).

Claim 67: In Mandler et al., page 8, claim 19, lines 4-7 there is disclosed a file system engine that receives a file request via a file system application programming interface wherein the request specifies file content of memorized files.

Page 8, claim 19, lines 8-12 disclose a parser linked to the linked to the file system engine that retrieves structural information of documents and further retrieves at least one of elements, attributes and values from documents.

Page 8, claim 19, lines 13-15 disclose an indexer linked to the parser for constructing an inverted index of the elements, attributes and values.

Page 8, claim 19, lines 16-21 states that responsive to a file request, the file system engine retrieves postings of the inverted index that satisfy requirements of the file request and returns a hierarchical tree of directories to the user.

FIG. 8 gives an example of the file system returning to the user a special virtual directory (the directory "Profile"). The content of this special virtual directory comprises at least one level within the hierarchy ("Ticker") that is more deeply nested than the parent node ("Profile") of the special virtual directory.

Claim 68: FIG. 8 illustrates the invocation of an operator (the directory path "F:/Profile/Ticker") and indicates a context node (the node "Ticker") and a parent node (the node "Profile").

Claim 76: Claim 20 of Mandler et al. states that the inverted index comprises a structural section having postings of said structural information and a words section having postings of words of the documents.

Claim 77: Claim 22 of Mandler et al. calls for an analyzer for updating the inverted index and analyzing additions to the memorized files.

Claim 78: Claim 23 of Mandler et al. calls for the parser to retrieve structural information from the documents.

Claim 79: See remarks for claim 67. Note that the Mandler et al. reference and claim 19 refer specifically to the analysis of XML documents.

Claim 80: See remarks for claim 68.

Claim 88: See remarks for claim 76.

Claim 89: See remarks for claim 77.

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Claim 90: See remarks for claim 78.

Claims 69 and 81 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**(10) Response to Argument**

Declarations Submitted Under 37 CFR 1.132

Preliminary Note: During the prosecution of the present application, appellant has submitted three different declarations, all three of which have been considered. Since appellant's brief provides no distinctions between these different declarations or any labeling to distinguish them from one another, some initial labeling is needed to individually discuss them.

Included with this Examiner's Answer, examiner has individually labeled:

"Declaration A" is the declaration submitted May 23, 2005, signed only by Benjamin Mandler.

"Declaration B" is declaration of Benjamin Mandler, Yoelle Maarek-Smadja, Alain Azagura and Michael Factor submitted December 5, 2005.

"Declaration C" are the declarations of Benjamin Mandler and Roman Talyansky submitted December 5, 2005.

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Consideration of the Declarations "A", "B" and "C" Submitted under 37 CFR 1.132:

"Declaration A" was the first submitted declaration received during the prosecution, following the non-final office action of February 23, 2005. The purpose of this declaration was

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to establish common inventorship between U.S. Pre-Grant Publication 2001/0049675 and the claimed invention so as to overcome the prior art rejection under 35 USC 102(e). Examiner found that Declaration A did not establish common inventorship between the U.S. Pre-Grant Publication and the claimed invention. In particular, Declaration A was only signed by Benjamin Mandler, and was not signed by any of the other inventors in the U.S. Pre-Grant Publication. The existence of the other inventors in the U.S. Pre-Grant Publication was contradictory evidence to Benjamin Mandler's assertion of sole inventorship. Secondly, no accounting was made in Declaration A for the co-inventor of the present application, Roman Talyansky, and his particular contributions to present invention and its claims. This is further contradictory evidence that does not support the unequivocal assertion of Benjamin Mandler. Given the existence of contradictory evidence, examiner further required the submission of objective evidence to clarify the record of inventorship. Such additional requirement was made in accordance with MPEP 716.10, including *Ex Parte Kroger* 218 USPQ 370 (Bd. App. 1982) and *In re Katz* 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (*"inquiry is appropriate to clarify any ambiguity created by article regarding inventorship and it then incumbent upon applicant to provide a satisfactory showing.."(emphasis added)*)

"Declaration B" was the next Declaration provided by applicant, and was submitted after the final rejection. Declaration B was fully considered. Declaration B contains the identical statements made in Declaration A, except that it is further signed by all four co-inventors listed in the Mandler et al. Pre-Grant Publication. Examiner further held that Declaration B was ineffective. In particular, no accounting is made for the contributions co-inventor in the present

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application, Roman Talyansky, and no further objective evidence is provided to clarify the record on the issue of inventorship.

“Declaration C” was the third and last declaration set submitted by appellant. It is composed of one statement, and was separately affirmed by both Benjamin Mandler and Roman Talyansky, the two co-inventors in the record of the present application. Here, Benjamin Mandler asserts sole inventorship of the pending claims 67-68, 76-80 and 88-90. This is followed by a statement that Roman Talyansky was a joint inventor on dependent claims 69 and 81. Claim 69 is a dependent claim which incorporate claims 67-68 by reference and claim 81 is a dependent claim which incorporates claim 79 by reference. The resulting declarations once again produce an ambiguous picture of inventorship. Since Roman Talyansky claimed inventorship on dependent claims that incorporate the subject matter of independent claims, his contribution to the independent claims cannot be fully ruled out. Again, examiner indicated that further objective evidence was required to clarify the record and made such indication in the advisory action of December 29, 2005.

#### Appellant's Arguments in the Appeal Brief

Appellant's arguments in the appeal brief make two fundamental assertions: (1) That the procedures set forth in the MPEP make no requirement for appellant to submit objective evidence in addition to unequivocal statements by the inventors; and (2) Notwithstanding the lack of requirement in the MPEP, appellant's declarations are in fact objective evidence.

The first assertion is incorrect. MPEP 716.10 provides the guidance for analyzing declarations related to the issue of attribution. The guidance clearly indicates that the presence of contradictory evidence must be considered, and that mere unequivocal statements are not



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sufficient when contradictory evidence is present. (MPEP 716.10: "*However, a statement by the applicants regarding their inventorship in view of an article, patent or published application may not be sufficient where there is evidence to the contrary*"). The presence of co-inventors in both the prior art and the present application, well as the submission of declarations which did not account for the activities of these co-inventors is contradictory evidence in the record. In light of this evidence, the examiner cannot just make a blanket assumption that unequivocal statements are sufficient, and may pursue further inquiry as described in *Katz* (cited herein). The further inquiry is the examiner's requirement for further objective information.

The second assertion is moot. Whether appellant's supplied Declarations can be labelled as "objective evidence" is not the issue of record. All of appellant's declarations have been fully considered, so whether they are called "objective evidence" or not does not really matter.

The question is whether all of the Declarations, combined together, establish a record of evidence that disproves inventorship by all the co-inventors in the prior art, as well as disproving inventorship by co-inventors in the present application, such that Benjamin Mandler is a sole inventor of both the applied portions of the prior art as well as the sole inventor of the pending claims under rejection.

Examiner maintains that such evidence that has not been clearly established, for the reasons already cited herein. Accordingly, the Declarations are not effective in establishing common inventorship.

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Consideration of Mandler et al. Pre-Grant Publication as it applies to claims

Appellant presents no arguments pertaining to the content of the Mandler et al. Pre-Grant Publication or its application to the claims. Accordingly, examiner's rejection of claims 67-68, 76-80 and 88-90 under 35 USC 102(e) is sustained. Appellant's lack of argument on this issue is considered further evidence that the rejection should be sustained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

Appeal Conference:

An appeal conference was held August 31, 2006 with Charles Rones, SPE and Tim Vo, SPE. Additional consultation was further made with Brian L. Johnson, SPRE, on August 31, 2006. All three conferees and the primary examiner of record agreed to proceed to appeal.



CHARLES RONES  
SUPERVISORY PATENT EXAMINER



SAM RIMELL  
PRIMARY EXAMINER

# DECLARATION A

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In Re Patent Application of: MANDLER et al.

Serial No.: 09/929,260

Filed: August 15, 2001

For: USE OF SPECIAL DIRECTORIES FOR ENCODING  
SEMANTIC INFORMATION IN A FILE SYSTEM

Group Art Unit: 2165

Examiner: Samuel G. Rimell

### RULE 132 DECLARATION OF BENJAMIN MANDLER

I, the undersigned, Benjamin Mandler of 6 Heharuv Street, Zichron Yaakov, Israel, hereby declare as follows:

1. I am one of the Applicants in U.S. Patent Application No. 09/929,260 (hereinafter "the Application").
2. I was also one of the Applicants in U.S. Patent Application Publication 2001/0049675 A1 (hereinafter "the Publication").
3. In an Office Action dated February 23, 2005, claims 67, 68, 76-80 and 88-90 in the aforesaid Application were rejected under 35 U.S.C. 102(e) over the Publication. In making this rejection, the Examiner cited subject matter shown in Fig. 8 of the Publication and described in claims 19, 20, 22 and 23 of the Publication.
4. I was the sole inventor of all the subject matter that was cited by Examiner in Fig. 8 and in claims 19, 20, 22 and 23 of the Publication.

A handwritten signature in black ink, appearing to be "B. Mandler", located at the bottom right of the page.


# DECLARATION A

In Re: U.S.S.N. 09/929,260

Group Art Unit 2165

Rule 132 Declaration of Benjamin Mandler, cont'd

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and conjecture are thought to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application of any patent issued thereon.

  
Benjamin Mandler, Citizen of Israel  
6 Heharuv Street, Zichron Yaakov  
April 19, 2005



# DECLARATION B

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of: MANDLER et al.

Serial No.: 09/929,260

Filed: August 15, 2001

For: USE OF SPECIAL DIRECTORIES FOR ENCODING  
SEMANTIC INFORMATION IN A FILE SYSTEM

Group Art Unit: 2165

Examiner: Samuel G. Rimell

### RULE 132 DECLARATION OF BENJAMIN MANDLER, YOELLE MAAREK- SMADJA, ALAIN AZAGURY AND MICHAEL FACTOR

We, the undersigned, Benjamin Mandler of 8 Heharuv Street, Zichron Yaakov, Israel, Yoelle Maarek-Smadja of 57 Albert Schweitzer Street, Haifa, Israel, Alain Azagury of 7 Shlonsky Street, Haifa, Israel, and Michael Factor of 32 Rachel Street, Haifa, Israel, hereby declare as follows:

1. We are the Applicants in U.S. Patent Application No. 09/873,084, published as US 2001/0049675 (hereinafter "the Publication"), which was cited against U.S. Patent Application No. 09/929,260 under 35 U.S.C. 102(e) in an Office Action dated August 8, 2005. In making this rejection, the Examiner cited subject matter shown in Fig. 8 of the Publication and described in claims 19, 20, 22 and 23 of the Publication.

2. Benjamin Mandler was the sole inventor of all the subject matter that was cited by Examiner in Fig. 8 and in claims 19, 20, 22 and 23 of the Publication.


# DECLARATION B

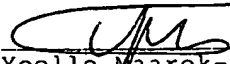
In Re: U.S.S.N. 09/929,260


Group Art Unit 2165

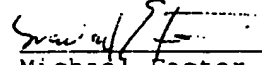
Rule 132 Declaration of Benjamin Mandler, Yoelle Maarek-Smadja, Alain Azagury, and Michael Factor, cont'd

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and conjecture are thought to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application of any patent issued thereon.

  
Benjamin Mandler, Citizen of Israel  
8 Heharuv Street, Zichron Yaakov  
November 20, 2005

  
Yoelle Maarek-Smadja, Citizen of Israel and France  
57 Albert Schweitzer Street, Haifa  
November 20, 2005

  
Alain Azagury, Citizen of Israel  
7 Shlonsky Street, Haifa  
November 20, 2005

  
Michael Factor, Citizen of Israel, USA  
32 Rachel Street, Haifa  
November 20, 2005



DECLARATION C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of: MANDLER et al.  
Serial No.: 09/929,260  
Filed: August 15, 2001  
For: USE OF SPECIAL DIRECTORIES FOR ENCODING  
SEMANTIC INFORMATION IN A FILE SYSTEM

Group Art Unit: 2165  
Examiner: Samuel G. Rimell

RULE 132 DECLARATION OF BENJAMIN MANDLER AND ROMAN

TALYANSKY

We, the undersigned, Benjamin Mandler of 8 Heharuv Street, Zichron Yaakov, Israel, and Roman Talyansky of 39/1 Naomi Street, Haifa, Israel, hereby declare as follows:

1. We are the Applicants in U.S. Patent Application No. 09/929,260 (hereinafter "the Application").
2. Benjamin Mandler was the sole inventor of claims 67, 68, 76-80 and 88-90 in the aforesaid Application.
3. Roman Talyansky and Benjamin Mandler jointly invented claims 69 and 81.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and conjecture are thought to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the

DECLARATION C

In Re: U.S.S.N. 09/929,260  
Group Art Unit 2165  
Rule 132 Declaration of Benjamin Mandler and Roman Talyansky,  
cont'd

validity of the application of any patent issued thereon.

\_\_\_\_\_  
Benjamin Mandler, Citizen of Israel  
8 Heharuv Street, Zichron Yaakov  
November 21, 2005

\_\_\_\_\_  
Roman Talyansky, Citizen of Israel  
39/1 Naomi Street, Haifa  
November 21, 2005





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of: MANDLER et al.

Serial No.: 09/929,260

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Examiner: Samuel G. Rimell

RULE 132 DECLARATION OF BENJAMIN MANDLER AND ROMAN

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In Re: U.S.S.N. 09/929,260

Group Art Unit 2165

Rule 132 Declaration of Benjamin Mandler and Roman Talyansky,  
cont'd

validity of the application of any patent issued thereon.

  
\_\_\_\_\_  
Benjamin Mandler, Citizen of Israel  
8 Heharuv Street, Zichron Yaakov  
November 21, 2005

\_\_\_\_\_  
Roman Talyansky, Citizen of Israel  
39/1 Naomi Street, Haifa  
November 21, 2005